

-- 39. A razor cartridge comprising a blade and a skin engaging member according to claim 38 affixed adjacent said blade. --

sub 5
-- ~~40.~~ A razor cartridge comprising a blade and a skin engaging member according to claim 27 affixed adjacent said blade. --

sub 757
-- 41. The razor cartridge of claim 31, 39 or 40 wherein said water soluble shaving aid comprises polyethylene oxide. --

REMARKS

This paper is in response to the Office Action mailed on March 24, 1999.

Acknowledgment of Information Disclosure Statement

Applicant has submitted a Supplemental Information Disclosure Statement herewith. Applicant requests that the Examiner acknowledge receipt of the PTO-1449 submitted herewith, as well as the PTO-1449 submitted on December 18, 1998, and return initialed copies of both with the next Office Action.

Response to double patenting rejection

Applicant has submitted a terminal disclaimer herewith, along with the necessary recordal fee, to obviate the provisional rejection of double patenting over Application No. 08/461,318.

Response to § 112 rejection

Claims 29-37 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for several reasons set forth by the Examiner. Applicant respectfully requests withdrawal of this rejection in view of the amendments submitted herewith and the arguments that follow.

Claim 29 has been amended by adopting the Examiner's suggestion. Claim 31 has been amended by dropping the multiple dependency. Accordingly, the rejection of claims 29 and 31 should now be obviated.

The Examiner has also objected to the "adapted to" terminology in claims 30 and 32 as being vague and indefinite. Applicant respectfully traverses this ground of rejection.

The Court of Customs and Patent Appeals (predecessor to the Federal Circuit) has sanctioned the use of functional language in claims and has specifically found "adapted to" language as satisfying 35 U.S.C. §112. In In re Swinehart, 169 USPQ 226, 228 (CCPA 1971), the Court recognized the practical necessity of utilizing functional language and held there was nothing intrinsically wrong with defining something "by what it does rather than by what it is." And in In re Venezia, 189 USPQ 149, 152 (CCPA 1976), the Court found that the "adapted to" language of the claim "imparts a structural limitation" and "serves to precisely define present structural attributes." The Court continued:

We see nothing wrong in defining the structures of the components of the completed ... assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly. More particularly, we find nothing indefinite in these claims.

Thus, it is clear from these decisions that the functional limitations of the present claims, and specifically the "adapted to" limitations, are appropriate. Accordingly, withdrawal of this ground of rejection is respectfully requested.

Response to § 102 and § 103 rejections

Castello

Claims 27 to 37 stand rejected under 35 U.S.C. § 102(b) as anticipated by Castello (US 4,931,051). Applicant respectfully traverses this rejection.

Castello discloses a wetness indicator for a diaper. The wetness indicator includes a hydratable salt such as copper sulfate, which is a white powder that turns blue when in contact with water. The salt is mixed with a water soluble binder such as a low molecular weight polyethylene glycol. This mixture may be layered on one or more additional layers of polyethylene glycol of somewhat higher molecular weight (see col. 5, lines 34-46, and col. 4, lines 4-8). Obviously, the Castello wetness indicator is designed to undergo a color change immediately upon contact with water.

Claim 27 is directed to a skin engaging member comprising a water insoluble polymer, a shaving aid, and means for gradually indicating a change in the amount of shaving aid. Castello discloses none of these components. Firstly, the Castello layers do not include a water-insoluble polymer. The polyethylene glycol is water soluble. Secondly, the Castello layers do not include a shaving aid. Although high molecular weight polyethylene oxide is a useful shaving aid, low molecular weight polyethylene glycol is not. Lastly, the Castello layers do not include a means for gradually indicating a change in the amount of shaving aid. The copper sulfate used by Castello changes immediately on contact with water. A single drop of water would cause a color change. This color change would occur without any loss of material. This type of immediate change cannot in any way suggest the gradual change required by the claim.

Since claim 27 is not anticipated by Castello, then claims 28 to 31 and 38 to 41, which depend therefrom, cannot be anticipated. Moreover, claims 31 and 39 to 41 are directed to a razor cartridge and cannot be anticipated by a diaper.

Claim 32 requires a skin engaging layer comprising a blend of polyethylene oxide and a water insoluble polymer. Castello does not teach a layer with these components. Rather, the Castello layer includes polyethylene glycol and

copper sulfate. In addition, claim 32 requires that the skin engaging layer is one color and is adapted to erode during use to visually expose the non-skin engaging layer, which is a different color. This is a structural feature that defines the mechanism by which the claimed skin engaging member undergoes a color change during use. The Castello wetness indicator is constructed entirely differently. The Castello outer layer contains the copper salt and changes color immediately upon contact with water. There is no suggestion whatsoever that other layers in the Castello wetness indicator are differently colored before use or become visibly exposed during use. In fact, this would make no sense and would not be possible since the other layers are not apparently colored.

Since claim 32 is not anticipated by Castello, then claims 33 to 37, which depend therefrom, cannot be anticipated. Moreover, these claims contain additional features not described by Castello, such as, for example, specific amounts of polyethylene oxide and specific water insoluble polymers. Since the Examiner has not asserted any other prior art against claims 32 to 37, and since Castello clearly does not anticipate these claims, allowance of claims 32 to 37 is earnestly requested.

Creasy

Claims 27 to 31 stand rejected under 35 U.S.C. § 102(b) as anticipated by Creasy (US 4,875,287). Applicant respectfully traverses this rejection.

Claim 27 requires that the skin engaging member include a water insoluble polymer, a water soluble shaving aid, and means for gradually indicating a change in the amount of shaving aid. The Examiner has misinterpreted the teachings of Creasy since Creasy does not describe or suggest all of these elements.

First, the claimed strip contains a water soluble shaving aid, such as polyethylene oxide, which leaches out of the strip and onto the skin during use. In contrast, Creasy describes a hydrogel strip which becomes slippery when wet, but which does not leach out any polymer or shaving aid. Thus, Creasy distinguishes his strip from those strips which deposit the lubricant on the skin. (See col. 2, lines 36-43.) In the Creasy hydrogel strip, the "water-soluble polymers are rendered insoluble to prevent their dissolution and separation from the surface of the skin-engaging portion in the presence of water" (col. 3, lines 3-6; emphasis added). Creasy states that the "current invention applies only to those effective water insoluble forms of these [hydrogel] materials" (col. 8, lines 4-5; emphasis added). The Creasy hydrogel strip is also described in Thoene (US 5,056,221, previously cited by

applicant), which confirms that such strips do not leach out the lubricious substances during shaving (see col. 2, lines 65-68).

Thus, Creasy and Thoene are directed to a completely different type of strip from that claimed herein. The skilled worker would not replace the insoluble hydrogel layer of these references with a water soluble shaving aid since this would completely destroy the nature and purpose of the Creasy and Thoene strips. One clearly would not modify the prior art in such a way as to destroy its mode of operation and the benefits provided therein. See, e.g., In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The Creasy and Thoene strips also differ from the claimed strip in that the hydrogel layer is not intended to erode during use to expose the substrate layer. The Creasy strip is said to have "considerable durability to withstand the constant abrasion incurred during the shaving process." (col. 5, lines 7-8). Likewise, the Thoene strip shows "no appreciable wear of the sliding surface 8 due to abrasion" (col. 6, lines 18-19). Thus, even if the Creasy/Thoene strip were modified so as to have a colored layer, such as, for example, a clear hydrogel layer over a colored plastic substrate layer (see, e.g., the Schick Protector cartridge submitted herewith), it would not undergo a color change because the hydrogel layer is not designed to wear off, and, even if it did wear off, the user would still see the same

colored substrate that was visible beneath the clear hydrogel on the unused strip. While the Examiner has suggested that color fading of some lubricating strips is known, applicant respectfully points out that this phenomenon occurs in polyethylene oxide containing strips such as that shown in Rogers and the Sensor For Women razor. This fading is not known to occur in Creasy/Thoene strips, nor would it be expected to occur.

Accordingly, claims 27 to 31 and 38 to 41 are clearly distinguishable from Creasy and allowance of these claims is earnestly requested.

Rogers/Althaus

Claims 20 to 25 stand rejected under 35 U.S.C. § 102(b) as anticipated by Rogers (US 5,113,585) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Rogers in view of Althaus (US 5,134,775). Claim 26 also stands rejected under 35 U.S.C. § 103(a) as obvious over Rogers in view of Althaus. Applicant respectfully traverses these rejections.

Claim 20 is directed to a razor cartridge with a certain type of improved skin engaging member (i.e., shaving aid strip) that differs substantially from anything described in the prior art of record. The skin engaging member has an outer polymeric sheath that surrounds an inner polymeric core. This construction allows higher levels of the polyethylene oxide shaving aid to be carried in the

outer sheath layer that contacts the skin. This is because the inner core provides the necessary mechanical strength to the skin engaging member.

Prior art single layer strips, such as is shown in Rogers (among others) and utilized in the Sensor For Women razor cartridge (among others), do not in any way remotely suggest a strip with the claimed structural configuration.

Rogers clearly cannot anticipate claim 20 (or any claim dependent therefrom) because this reference only describes a single layer strip with a uniform composition throughout. There is absolutely no suggestion anywhere in Rogers to modify the structure of the single layer strip described therein. The Examiner has apparently recognized this deficiency in Rogers and has cited Althaus in an effort to make up for this deficiency. The Examiner has referred to Figs. 5-6b of Althaus as suggesting a core to store and dispense additional shaving aid. However, the Examiner has overlooked some key distinguishing features between the claimed invention and Althaus.

It is important to understand that Althaus intended to develop a shaving aid delivery system that operated completely differently from the previously known solid polymeric shaving aid strips. In the background to his invention, Althaus acknowledges the two known types of solid polymeric shaving aid strips, namely strips based on polyethylene oxide/polystyrene blends (e.g., a Rogers type

strip) and strips based on a hydrogel film (e.g., a Creasy type strip). Althaus then goes on to describe his system, the object of which is to deliver liquid shaving preparations (col. 2, lines 14-17). Thus, all of the various embodiments described by Althaus are designed to store and deliver liquid preparations (col. 7, lines 9-10). Most of the embodiments include a hollow chamber, such as storage chamber 8 shown in Fig. 6, to hold the liquid preparation (see col. 7, lines 16-19, and col. 8, lines 26-45). Other embodiments, such as is shown in Figs. 11-14, include a sponge-like element to retain the liquid preparation (col. 7, lines 19-22).

The claimed invention does not embrace any structure for holding and dispensing a liquid preparation. It would be completely unreasonable to interpret Althaus' hollow chamber as a core. Even when the chamber is filled with a liquid preparation, as suggested by Althaus, this structure cannot, by any stretch, suggest the solid polymeric core of the claimed device.

In addition, Althaus does not suggest an outer structure (or sheath) that comprises polyethylene oxide and a water insoluble matrix (e.g., polystyrene) as claimed. This is precisely the type of shaving aid composition that Althaus is trying to avoid. The skilled worker would hardly be motivated to use a material specifically taught away from by the reference. In fact, doing so would make no sense

because the liquid in the chamber might interact with the soluble polyethylene oxide, causing the outer structure to deteriorate.

Lastly, there is no reasonable way one can combine Rogers with Althaus. They describe two completely different types of structures that are designed to deliver two completely different types of shaving aid. Absent the direction provided by the present specification, a skilled worker, given these two references, would not arrive at the claimed device. An attempt to combine these two references is clearly an impermissible hindsight reconstruction.

Accordingly, for the above reasons, applicant respectfully requests withdrawal of the rejections applied against claims 20 to 26, and allowance of these claims.

Potentially Interfering Claims With Wexler et al.

The Examiner is respectfully reminded that claims 27-31 and 38-41 are substantially similar to claims originally presented in Wexler et al. PCT published application WO 96/04112. Applicant previously requested that an interference be declared between applicant's Application No. 08/461,318 and Wexler et al.'s U.S. applications corresponding to the PCT application, including Wexler et al. U.S. Application No. 08/285,364. Applicant respectfully requests that the Examiner determine whether any Wexler et al. U.S. application has an allowable claim

that would be appropriate for declaration of an interference
with this application or the '318 application.

An early and favorable action is respectfully requested.

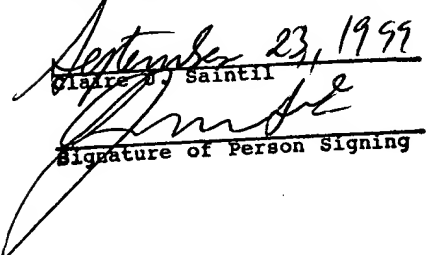
Respectfully submitted,



John E. Nathan
Registration No. 26,778
Richard A. Inz
Registration No. 31,375
Attorneys for Applicant
c/o FISH & NEAVE
1251 Avenue of the Americas
New York, New York 10020
Tel.: (212) 596-9000

I Hereby Certify that this
Correspondence is being
Deposited with the U.S.
Postal Service as First
Class Mail in an Envelope
Addressed to: ASSISTANT
COMMISSIONER FOR
PATENTS
WASHINGTON, D.C. 20231 on

September 23, 1999
Claire B. Saintil


Signature of Person Signing